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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,236	05/04/2001	Ulrich R. Bernier	0148.01	7271

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EXAMINER

CHOI, FRANK I

ART UNIT PAPER NUMBER

1616

DATE MAILED: 01/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/848,236

Applicant(s)

BERNIER ET AL.

Examiner

Frank I Choi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 15, 20, 22-30, 36, 40 and 43-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15, 20, 22-30, 36, 40 and 43-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1, 4.                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 15, 20, 22-30, 36, 40, 43, 51, 57, 63, 65, 78, 89, 91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 of U.S. Patent No. 6,267,953. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the application and patent claims compositions and methods for attracting mosquitoes, which are arthropods, containing lactic acid and acetone and/or dimethyl disulfide.

Although this application is a divisional of said patent which was subject to a restriction requirement, i.e. an election of species requirement, a double patenting rejection is proper as Applicant has not made a clear demarcation between the elected invention of the parent application and the claimed invention of the present divisional application in that the Applicant is also claiming the elected invention of said parent application in the present divisional application (See *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 16 USPQ2d 1436 (Fed. Cir. 1990)).

***Claim Objections***

Claim 43 objected to because of the following informalities: Claim 43, line 1, “formula 1” should be “formula I”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 15, 20, 22-30, 36, 40, 43-96 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific embodiments, i.e. those compounds or mixtures of compounds which were tested and found to be effective in attracting *Aedes aegypti*, *Aedes albopictus* and *Anopheles albimanus* does not reasonably provide enablement for the all compounds or mixtures of compounds with respect all arthropods, or even all mosquitos. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/and or use the invention commensurate in scope with these claims. For instance, lactic acid is known to be a repellant to tsetse flies (See Voskamp et al., Abstract; Mihok et al., Abstract; Saini et al., Abstract). Further, different species of mosquitos are effected differently, i.e. - attracted, repelled or non-responsive, by various compounds, including compounds falling within the scope of Applicant’s invention (See Takken et al. (1999), pgs 140-45; Schreck et al. (1990), pg. 409, Table 2; Kline et al. (1990), pg. 386-90). Furthermore, even with respect to *Aedes aegypti*, altering the base structure

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of lactic acid has varying effects of the attractancy and/or repellancy of the lactic acid derivative to *Ae. aegypti* (See Carlson et al. (1973), pgs 329-331; Davis (1988), pg. 445, Table 1). As such, in light of the above, it appears that a skilled artisan would be required to do undue experimentation in order to make and/or use the invention commensurate in scope with the claims.

Claims 20, 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20, 40 are indefinite as it is not clear from the claim language whether the compositions are intended to contain all of the compounds listed as Group II compounds or if the limitation set forth in claim 1 on which said claims are dependent which indicates that the compound contains at least one Group II compound is applicable such that the composition contains one or more of the listed Group II compounds.

***Claim Rejections - 35 USC § 102/103***

Claims 1-9, 15, 20, 43-45, 49, 51, 71, 72, 76, 78 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious Granata et al..

Granata et al. expressly disclose a product comprising lactic acid, acetone, 2-butanone, 2,3-pentanedione, 2-heptanone, 3-hydroxy-2-butanone, diacetyl, acetaldehyde, ethanol, hexanol, trichloromethane, 2-ethyl furan, benzene and dimethyl disulfide falling within the scope of applicant's claims (Pg. 333-34, Lactic acid production, Pg. 335, Table 8, Volatile compound composition).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

Claims 1-9, 15, 20, 43-45, 49, 51, 53, 71, 72, 76, 78, 80 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious *Laye et al.*.

*Laye et al.* expressly disclose a product comprising lactic acid, pyruvic acid, acetone, 2-butanone, diacetyl, 2,3-pentanedione, 2-heptanone, 2-hydroxy-2-butanone, 2-nonanone, acetaldehyde, 2-propanol, ethanol, methyl benzene, dimethyl sulfide, dimethyl disulfide and benzothiazole falling within the scope of applicant's claims (Pg. 992-94, Lactose and organic acids, Volatile compounds, Tables 5-8).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

Claims 1-9, 15, 19, 20, 22-30, 36, 40, 43, 49, 57, 60, 61, 63, 65, 73, 86, 89, 91 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/26661.

WO 98/26661 expressly discloses compositions comprising lactic acid and limburger cheese for attracting arthropods, including mosquitos falling within the scope of applicant's claims (Page 13, lines 13-30, Page 14, lines 1-3, Page 19, lines 5-26). Limburger cheese

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contains phenylacetaldehyde, acetone, 2,3-butanedione, 2-pentanone, 2-hexanone, 2-heptanone,, dimethyl disulfide, dimethyl trisulfide, .

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See In re May, 197 USPQ 601, 607 (CCPA 1978). See also Ex parte Novitski, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993).

### ***Conclusion***

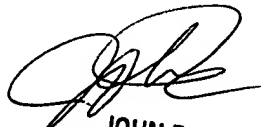
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

December 31, 2001

  
JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600

